

REMARKS

Claims 1-5, 8, 13-15, 17-19 and 49-54 are pending in this application. Claims 13 and 20-48 are cancelled, without prejudice. Applicants note with appreciation that the Examiner has indicated that claims 1-3, 8 and 49-51 are allowable and that claims 14 and 15 would be allowable if amended to include the limitations contained in the claims from which they depend. Applicants have amended claim 14 to include the limitations of claim 13.

Claims 4, 5, 8 and 52 are amended to more clearly define the invention. No new matter has been introduced. As to claims 4, 5 and 8, "arm" is used within the specification to refer to two different types of structures: first, in Figures 16-26 and 29, where "arm" is referred to as reference numeral 204, which refers to a ball-and-socket-type shaft; and, second, in Figures 27-43, where "arm" is referred to as at least reference numerals 263, 265, 304, 306, and 302, 302A, which refer to portions of a foot. Applicants have amended claims 4, 5 and 13 to more clearly define the claimed invention such that "arm" is replaced with "shaft", where appropriate.

The Examiner rejected claim 19 under 35 U.S.C. § 112, first paragraph as containing subject matter not described in such a way to enable one skilled in the art to make/use the invention. Applicants traverse this rejection. Among other locations within the specification, page 21, lines 16-22 describe using more than one foot to perform multi-vessel bypass surgery, wherein the feet are shaped differently so as to stabilize different vessels located on different parts of the heart. In addition, other parts of the specification describe detachable feet that are shaped differently, and the originally filed specification included claim 19, which, in itself, provides the necessary enablement for teaching one skilled in the art to practice the method. As such, Applicants request the Examiner to withdraw this rejection.

Anticipation Rejection

The Examiner rejected claims 4, 13, 17-19 and 52 under 35 U.S.C. § 102(e) as being anticipated by Cartier (U.S. Patent No. 6,102,854). Applicants have cancelled claim 13, without prejudice. Applicants respectfully traverse this rejection with respect to claims 4, 17-19 and 52.

Referring to claim 4, Cartier does not teach or disclose an apparatus for stabilizing an epicardial surface of the heart that has a shaft and a foot coupled to the shaft, where the foot has a slot aligned with a central axis, and where the foot has a shape that is asymmetrical relative to the central axis. An example of such a foot is shown in Figure 39 of the present application. The Examiner points to Figures 2 and 26 of Cartier as disclosing examples that best show feet that are asymmetrical relative to a central axis. Applicants submit, however, that neither these figures nor any other depicted in Cartier show a foot that has a shape that is asymmetrical relative to the central axis. On the contrary, the feet of Cartier each have a slot that is aligned with a central axis, yet the shape of the foot is asymmetric relative to the central axis. For example, Figure 26 depicts a shaft 70 having a contacting member 30 provided at the distal end of shaft 70. In this case, contacting member 30 has an opening that defines a slot between two portions of member 30. This slot is aligned with a central axis and the two portions of member 30 are symmetrical about the central axis. The difference between the Cartier feet as compared to, for example, the foot disclosed in Figure 39 of the current application, is plain. Applicants have reviewed each of the feet disclosed in Cartier and submit that Cartier does not describe or teach a foot that is asymmetric with respect to a central axis. As a result, Cartier can not anticipate claim 4, and Applicants request that the Examiner withdraw the rejection with respect to claim 4.

Regarding claims 17-19, the Examiner states that the method steps would have been inherently carried out in the operation of the device described in Cartier. To support a *prima facie* case of anticipation by inherency, the limitation in question must "necessarily" be present in the prior art reference. *In re Robinson*, 169 F.3d 743 (Fed. Cir. 1999). In this case, there is no basis to suggest that the device disclosed in Cartier would be used in the manner described in claims 17-19. With regard to claims 17 and 18, Cartier does not teach or suggest a method that includes the step of placing a foot in engagement with the heart so that the coronary artery is positioned in the slot and the first arm retracts the apex of the heart. In fact, Cartier does not mention the "apex" of the heart anywhere in its specification. Further, with regard to claim 19, while Cartier does describe feet having different shapes, Cartier does not teach or suggest feet that are removably coupled to a shaft. Instead, Cartier describes feet that are attached to a shaft (See Figures 24-31). As such, Applicants submit that claims 17-19 are patentably distinguished over Cartier, and request the Examiner to withdraw the rejection with respect to claims 17-19.

Regarding claim 52, the Examiner states that Cartier discloses a foot having a connector (20) for detachably engaging a positioning apparatus of the stabilizer. Applicants have amended claim 52 to more clearly define the invention to include a shaft and a foot having a connector for detachably engaging the foot to the shaft. As described above, Cartier does not teach or suggest feet that are removably coupled or detachably engaged to a shaft. As such, Applicants submit that claim 52 is patentably distinguished over Cartier, and request the Examiner to withdraw the rejection with respect to claim 52.

Obviousness Rejection

The Examiner rejected claims 5, 53 and 54 under 35 U.S.C. § 103(a) as being unpatentable over Cartier. Applicants traverse this rejection. As to claim 5, which depends from claim 4, Applicants submit that it is allowable for the same reasons stated above in connection with claim 4, and additionally because claim 5 is separately patentable as Cartier does not disclose foot that includes a first arm, and a second arm that is shaped differently compared to the first arm. With respect to claims 53 and 54, these claims are separately patentable, but are submitted as patentable for at least the same reasons as the base claim from which they depend. As described in the prior amendment, Applicants are under no burden to show that any particular feature is critical as a condition to patentability, particularly where no prior art teaches or suggests the claimed feature. As such, Applicants respectfully request the Examiner to withdraw the rejection.

If the Examiner believes that a discussion of the pending claims would expedite the prosecution of this application, she is invited to contact the undersigned.

Respectfully submitted,

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